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EXAMINER

RIVIERE, HEIDI M

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ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 10/506,677	Applicant(s) YAMAMOTO, TAKU	
	Examiner HEIDI RIVIERE	Art Unit 3689	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 September 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-55 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-55 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>9/17/2004; 11/23/2004</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Information Disclosure Statement

1. The Information Disclosure Statements filed **17 September 2004 and 23 November 2004** have been considered. Initialed copies of the Form 1449 are enclosed herewith.

Claim Objections

2. **Claims 6-7, 10, 13-19, 22, 23, 39-42, 47, 51, 53, and 54** are objected to under 37 CFR 1.75(c) as being in improper form because they are all multiple dependent claim. See MPEP § 608.01(n). Almost half of the claims presented are improper and present difficulty in claim mapping. Accordingly, the **claims 6-9, 10, 14-23, 39-42, 47, 51, 53, and 54** are not been further treated on the merits. These claims were reviewed below as best possible in light of the many improper multiple dependent claims.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. **Claims 1, 24-29 and 43-55** are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

5. **With respect to claim:** Claims 1 is not statutory.

In order for a method to be considered a "process" under §101, a claimed process must either: (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials). *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972). If neither of these requirements is met by the claim, the method is not a patent eligible process under §101 and is non-statutory subject matter. With respect to claim 1, the claim language does not include the required tie or transformation and thus is directed to nonstatutory subject matter. The "information" is received, stored, extracted and transmitted and undergoes no transformation or change from its original state.

6. **With respect to claims 24-26, 43:** These claims disclose "a recycle guarantee server". "Server" is not a recognized statutory class.

35 USC 101 requires that in order to be patentable the invention must be a "new and useful process, machine, manufacture, or composition or matter, or any new and useful improvement thereof" (emphasis added). Applicant's claims mentioned above do not disclose either of these statutory classes.

7. **With respect to claim 27:** Claim 27 discloses a program which is not a statutory class. 35 USC 101 requires that in order to be patentable the invention must be a "new and useful process, machine, manufacture, or composition or matter, or any new and useful improvement thereof" (emphasis added). Applicant's claims mentioned above do not disclose either of these statutory classes.

8. **With respect to claims 28-29:** These claims disclose a software which cannot be claimed and is not a recognized statutory class.

35 USC 101 requires that in order to be patentable the invention must be a “new and useful process, machine, manufacture, or composition or matter, or any new and useful improvement thereof” (emphasis added). Applicant’s claims mentioned above do not disclose either of these statutory classes.

9. **With respect to claims 44-54:** These claims depend on claims 43 which claims a server while they in turn claim a different class. For example, claims 44-46 teach a method, while 47 teaches a program and 48-54 teach a product.

35 USC 101 requires that in order to be patentable the invention must be a “new and useful process, machine, manufacture, or composition or matter, or any new and useful improvement thereof” (emphasis added). A server and a program are not recognized statutory classes. And therefore, all claims which depend from such claims are non-statutory as well.

10. **With respect to claim 55:** Claim 55 discloses “an account”, which is not a statutory class. 35 USC 101 requires that in order to be patentable the invention must be a “new and useful process, machine, manufacture, or composition or matter, or any new and useful improvement thereof” (emphasis added). Applicant’s claims mentioned above do not disclose either of these statutory classes.

Claim Rejections - 35 USC § 112

11. The following is a quotation of the second paragraph of 35 U.S.C. 112:

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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

12. **Claims 24-27 and 43-54** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

13. **With respect to claims 24-26 and 43-54:** An individual wishing to avoid infringement would not be reasonably made aware of the scope of the claimed invention. Applicant claims a mixture of non-statutory classes and statutory classes. The claims are confusing as written because not only is there the perplexing improper multiple dependent claim issue detailed above but also the way they are written.

14. **With respect to claim 27:** Claim 27 is confusing as written as it is unclear what Applicant claims as his invention. Although both are non-statutory it remains unclear if Applicant is claiming a program or a server. Therefore, there is insufficient antecedent basis for this claim.

Claim Rejections - 35 USC § 102

15. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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16. **Claims 31-34** are rejected under 35 U.S.C. 102(e) as being anticipated by **Wagner et al. (US 7,328,842 B2)**.

17. **With respect to claim 31:** Wagner teaches method of selling product with recycle guarantee information, wherein the recycle guarantee information refers to conditions for regenerating a material of the product, a criterion for determining a satisfaction level of the product with respect to the material regenerating conditions, and a collecting condition of the product depending upon the satisfaction level of the product. (col. 30, line 56- col. 31, line 7; col. 33, lines 1-19 – rating system for client to rate product; system can be instructed to provide confirmatory communications via email or a website page etc.)

18. **With respect to claim 32:** Wagner teaches the recycle guarantee information is directly indicated on the material. (col. 5, lines 35-51 – scanner used to scan item packaging)

19. **With respect to claim 33:** Wagner teaches the material recycling information is printed on paper and are attached on the material. (col. 5, lines 35-51 – scanner used to scan item packaging)

20. **With respect to claim 34:** Wagner teaches the recycle guarantee information is recorded in a computer-readable medium and is attached on the material. (col. 5, lines 35-51 – barcode or RFID scanner attached to trash can lid)

21. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

22. **Claim 29** is rejected under 35 U.S.C. 102(b) as being anticipated by **Warsing et al. (US 5,842,652)**.

23. **With respect to claim 29:** Warsing teaches a medium on which recycle guarantee information for recycling a used product is recorded, the material recycling information including conditions for regenerating a material of the product, a criterion for determining a satisfaction level of the product with respect to the material regenerating conditions, and a collecting condition of the product depending upon the satisfaction level of the product. (col. 5, lines 20-48; col. 6, lines 10-25 – scanner/reader used to enter information regarding type of material code into computer)

24. **Claim 55** is rejected under 35 U.S.C. 102(b) as being anticipated by **Suzuki et al. (US 6,226,617 B1)**.

25. **With respect to claim 55:** Suzuki teaches an account adapted to pay a collection fee of a product waste, wherein an amount of the collection fee is searched on the basis of information for identifying recycle guarantee conditions indicated on the product and stored in a data processing unit, and the data processing unit outputs the amount of the collection fee in response to the information for identifying the recycle guarantee conditions. (Fig. 2-6; col. 7, 40-67; col. 9, lines 1-55 - product acquisition data obtained from product; information on recycling the product determined from factory

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capability; product acquisition data obtained from product; product separation information stored in system)

Claim Rejections - 35 USC § 103

26. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

27. **Claims 1-11, 24-28, 35-39 and 43-54** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Suzuki** in view of **Warsing**.

28. **With respect to claims 1 and 24:** Suzuki teaches:

- receiving recycle guarantee conditions of a material constituting a product; (fig. 2-6; col. 7, 40-67; col. 9, lines 1-55 - product acquisition data obtained from product; information on recycling the product determined from factory capability; product acquisition data obtained from product; product separation information stored in system)
- receiving the guarantee code of the material from a product maker terminal, extracting the stored recycle guarantee conditions on the basis of the received guarantee code, and transmitting the extracted recycle guarantee conditions to the product maker's terminal; and receiving the guarantee code of the product from a consumer's terminal, extracting the recycle guarantee conditions on the basis of the received guarantee code,

and transmitting the extracted recycle guarantee conditions to the consumer's terminal. (fig. 2-6; col. 7, 40-67; col. 9, lines 1-55; col. 10, lines 1-34 - product acquisition data obtained from product; information on recycling the product determined from factory capability; product acquisition data obtained from product; product separation information stored in system; product information stored in database)

While Suzuki does not teach the following limitation, Warsing teaches:

- storing the received recycle guarantee conditions together with a guarantee code of the material and a guarantee code of a product made of the material; (col. 5, lines 20-48; col. 6, lines 10-25 – scanner/reader used to enter information regarding type of material code into computer)

It would have been obvious to one ordinary skill in the art at the time of the invention to combine the teachings of Suzuki and Warsing because both inventions teach waste processing/recycling and the idea of reading information from the product by using a scanner. Warsing teaches in col. 4, lines 18-28 that there are various codes marked inside the recycling design triangle. These codes are able to be scanned. Suzuki teaches that prior to recycling a product the information on the product can be acquired and used to determine the disposal method for and content of the product. There is also information on the product stored in a database within the system.

29. **With respect to claim 2:** Suzuki teaches, wherein the server transmits recycle guarantee conditions for respective waste disposal methods in place of the recycle guarantee conditions for the material. (fig. 2-6; col. 7, 40-67; col. 9, lines 1-55; col. 10,

lines 1-34 - product acquisition data obtained from product; information on recycling the product determined from factory capability; product acquisition data obtained from product; product separation information stored in system; product information stored in database)

30. **With respect to claim 3:** Suzuki teaches the server transmits information concerning environmental loads of the respective waste disposal methods. (fig. 2-6; col. 7, 40-67; col. 9, lines 1-55; col. 10, lines 1-34 - product acquisition data obtained from product; information on recycling the product determined from factory capability; product acquisition data obtained from product; product separation information stored in system; product information stored in database)

31. **With respect to claim 4:** Suzuki teaches the limitations in the rejections cited above. Suzuki does not teach, however Warsing teaches the same guarantee code is assigned to the material and the product. (col. 5, lines 20-48; col. 6, lines 10-25 – scanner/reader used to enter information regarding type of material code into computer)

It would have been obvious to one ordinary skill in the art at the time of the invention to combine the teachings of Suzuki and Warsing because both inventions teach waste processing/recycling and the idea of reading information from the product by using a scanner. Warsing teaches in col. 4, lines 18-28 that there are various codes marked inside the recycling design triangle. These codes are able to be scanned. Suzuki teaches that prior to recycling a product the information on the product can be acquired and used to determine the disposal method for and content of the product. There is also information on the product stored in a database within the system.

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32. **With respect to claim 5:** Suzuki teaches the limitations in the rejections cited above. Suzuki does not teach, however Warsing teaches different guarantee codes are assigned to the material and the product. (col. 5, lines 20-48; col. 6, lines 10-25 – scanner/reader used to enter information regarding type of material code into computer)

It would have been obvious to one ordinary skill in the art at the time of the invention to combine the teachings of Suzuki and Warsing because both inventions teach waste processing/recycling and the idea of reading information from the product by using a scanner. Warsing teaches in col. 4, lines 18-28 that there are various codes marked inside the recycling design triangle. Any product can get the same marking if they contain the same type of resin. These codes are able to be scanned. Suzuki teaches that prior to recycling a product the information on the product can be acquired and used to determine the disposal method for and content of the product. There is also information on the product stored in a database within the system.

33. **With respect to claims 6 and 8:** Suzuki teaches the server issues the guarantee code of the material. (col. 7 lines 60-67; col. 8, line 65-col. 9, line 15 – product information is stored and obtained from facility database)

34. **With respect to claim 7:** Suzuki/Warsing teach the limitations cited in the rejections above. Suzuki/Warsing do not teach the following limitation however, Wagner teaches the guarantee code of the material is inputted from a material selling agent. (col. 8, lines 42-67 – when no code is found, the code is manually inputted into the system)

It would have been obvious to one ordinary skill in the art at the time of the invention to combine the teachings of Suzuki/Warsing and Wagner because both inventions teach waste processing/recycling and the idea of reading information from the product by using a scanner. The Suzuki/Warsing codes are able to be scanned. Suzuki teaches that prior to recycling a product the information on the product can be acquired and used to determine the disposal method for and content of the product. Wagner teaches the code which contains information about the product can be inputted as well.

35. **With respect to claim 9:** Suzuki/Warsing teach the limitations cited in the rejections above. Suzuki/Warsing do not teach the following limitation however, Wagner teaches the guarantee code of the product is inputted from the product maker's terminal. (col. 8, lines 42-67 – when no code is found, the code is manually inputted into the system)

It would have been obvious to one ordinary skill in the art at the time of the invention to combine the teachings of Suzuki/Warsing and Wagner because both inventions teach waste processing/recycling and the idea of reading information from the product by using a scanner. The Suzuki/Warsing codes are able to be scanned. Suzuki teaches that prior to recycling a product the information on the product can be acquired and used to determine the disposal method for and content of the product. Wagner teaches the code which contains information about the product can be inputted as well.

36. **With respect to claims 10, 11, 25, 26, 38 and 46:** Suzuki teaches:

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- calculating a waste collecting condition of the product on the basis of the determined satisfaction level of the product; and sending the calculated waste collecting condition to the consumer. (fig. 2, item 100; col. 7, 40-67 - product acquisition data obtained from product)

Suzuki/Warsing teach the limitations cited in the rejections above.

Suzuki/Warsing do not teach the following limitation however, Wagner teaches

- receiving information necessary for determining a satisfaction level of the product with respect to the recycle guarantee conditions for the material; determining a satisfaction level of the product on the basis of the recycle guarantee conditions for the material and satisfaction level determining information of the product; (col. 30, line 56- col. 31, line 7 – rating system for client to rate product)

It would have been obvious to one ordinary skill in the art at the time of the invention to combine the teachings of Suzuki/Warsing and Wagner because both inventions teach waste processing/recycling and the idea of reading information from the product by using a scanner. The Suzuki/Warsing codes are able to be scanned. Suzuki teaches that prior to recycling a product the information on the product can be acquired and used to determine the disposal method for and content of the product. Wagner teaches that prior to disposal or reorder information regarding customer's opinion of product can be determined via a questionnaire.

37. **With respect to claim 27:** A Suzuki teaches the limitations in the rejections cited above. Suzuki does not teach, however Warsing teaches a recycle guarantee program

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enabling a computer to function as the recycle guarantee server of any one of claims 24 to 26. (col. 5, lines 20-48; col. 6, lines 10-25 – scanner/reader used to enter information regarding type of material code into computer)

It would have been obvious to one ordinary skill in the art at the time of the invention to combine the teachings of Suzuki and Warsing because both inventions teach waste processing/recycling and the idea of reading information from the product by using a scanner. Warsing teaches in col. 4, lines 18-28 that there are various codes marked inside the recycling design triangle. These codes are able to be scanned. Suzuki teaches that prior to recycling a product the information on the product can be acquired and used to determine the disposal method for and content of the product. There is also information on the product stored in a database within the system.

38. **With respect to claim 28:** Suzuki teaches the limitations in the rejections cited above. Suzuki does not teach, however Warsing teaches a medium having the recycle guarantee program of claim 27 recorded thereon. (col. 5, lines 20-48; col. 6, lines 10-25 – scanner/reader used to enter information regarding type of material code into computer)

It would have been obvious to one ordinary skill in the art at the time of the invention to combine the teachings of Suzuki and Warsing because both inventions teach waste processing/recycling and the idea of reading information from the product by using a scanner. Warsing teaches in col. 4, lines 18-28 that there are various codes marked inside the recycling design triangle. These codes are able to be scanned. Suzuki teaches that prior to recycling a product the information on the product can be

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acquired and used to determine the disposal method for and content of the product.

There is also information on the product stored in a database within the system.

39. **With respect to claim 35:** Suzuki teaches:

- storing the received recycle guarantee conditions in correlation to a recycle guarantee information identifier for identifying the recycle guarantee conditions; storing a guarantee code of a product made of the material in correlation to the recycle guarantee information identifier; and receiving the guarantee code of the product, extracting the stored recycle guarantee conditions on the basis of the received guarantee code, and transmitting the extracted recycle guarantee conditions. (fig. 2-6; col. 7, 40-67; col. 9, lines 1-55 - product acquisition data obtained from product; information on recycling the product determined from factory capability; product acquisition data obtained from product; product separation information stored in system)

Suzuki does not teach, however Warsing teaches:

- receiving recycle guarantee conditions for a material constituting a product; (col. 5, lines 20-48; col. 6, lines 10-25 – scanner/reader used to enter information regarding type of material code into computer)

It would have been obvious to one ordinary skill in the art at the time of the invention to combine the teachings of Suzuki and Warsing because both inventions teach waste processing/recycling and the idea of reading information from the product by using a scanner. Warsing teaches in col. 4, lines 18-28 that there are various codes

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marked inside the recycling design triangle. These codes are able to be scanned. Suzuki teaches that prior to recycling a product the information on the product can be acquired and used to determine the disposal method for and content of the product. There is also information on the product stored in a database within the system.

40. **With respect to claim 36:** Suzuki teaches the limitations in the rejections cited above. Suzuki does not teach, however Warsing teaches the server issues the guarantee code for the product. (col. 5, lines 20-48; col. 6, lines 10-25 – scanner/reader used to enter information regarding type of material code into computer)

It would have been obvious to one ordinary skill in the art at the time of the invention to combine the teachings of Suzuki and Warsing because both inventions teach waste processing/recycling and the idea of reading information from the product by using a scanner. Warsing teaches in col. 4, lines 18-28 that there are various codes marked inside the recycling design triangle. These codes are able to be scanned. Suzuki teaches that prior to recycling a product the information on the product can be acquired and used to determine the disposal method for and content of the product. There is also information on the product stored in a database within the system.

41. **With respect to claim 37:** Suzuki teaches the limitations in the rejections cited above. Suzuki does not teach, however Warsing teaches the server receives the guarantee code of the product. (col. 5, lines 20-48; col. 6, lines 10-25 – scanner/reader used to enter information regarding type of material code into computer)

It would have been obvious to one ordinary skill in the art at the time of the invention to combine the teachings of Suzuki and Warsing because both inventions

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teach waste processing/recycling and the idea of reading information from the product by using a scanner. Warsing teaches in col. 4, lines 18-28 that there are various codes marked inside the recycling design triangle. These codes are able to be scanned. Suzuki teaches that prior to recycling a product the information on the product can be acquired and used to determine the disposal method for and content of the product. There is also information on the product stored in a database within the system.

42. **With respect to claim 39:** Suzuki teaches the limitations in the rejections cited above. Suzuki does not teach, however Warsing teaches the collecting condition refers to information concerning a waste collecting fee. (col. 5, lines 20-48; col. 6, lines 10-25 – scanner/reader used to enter information regarding type of material code into computer)

It would have been obvious to one ordinary skill in the art at the time of the invention to combine the teachings of Suzuki and Warsing because both inventions teach waste processing/recycling and the idea of reading information from the product by using a scanner. Warsing teaches in col. 4, lines 18-28 that there are various codes marked inside the recycling design triangle. These codes are able to be scanned. Suzuki teaches that prior to recycling a product the information on the product can be acquired and used to determine the disposal method for and content of the product. There is also information on the product stored in a database within the system.

43. **With respect to claim 43:** Suzuki teaches:

- a receiver receiving recycle guarantee conditions for a material of a product; a storage storing the received recycle guarantee conditions

together with a recycle guarantee information identifier for identifying the recycling conditions; (fig. 2-6; col. 7, 40-67; col. 9, lines 1-55 - product acquisition data obtained from product; information on recycling the product determined from factory capability; product acquisition data obtained from product; product separation information stored in system)

Suzuki does not teach, however Warsing teaches:

- a storage storing a guarantee code of the product in correlation to the recycle guarantee information identifier; and a receiver receiving the guarantee code of the product, extracting the recycle guarantee conditions on the basis of the guarantee code, and sending the recycle guarantee conditions. (col. 5, lines 20-48; col. 6, lines 10-25 – scanner/reader used to enter information regarding type of material code into computer)

It would have been obvious to one ordinary skill in the art at the time of the invention to combine the teachings of Suzuki and Warsing because both inventions teach waste processing/recycling and the idea of reading information from the product by using a scanner. Warsing teaches in col. 4, lines 18-28 that there are various codes marked inside the recycling design triangle. These codes are able to be scanned. Suzuki teaches that prior to recycling a product the information on the product can be acquired and used to determine the disposal method for and content of the product. There is also information on the product stored in a database within the system.

44. **With respect to claim 44:** Suzuki teaches the limitations in the rejections cited above. Suzuki does not teach, however Warsing teaches the server includes a unit

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issuing the guarantee code for the product on the product. (col. 5, lines 20-48; col. 6, lines 10-25 – scanner/reader used to enter information regarding type of material code into computer)

It would have been obvious to one ordinary skill in the art at the time of the invention to combine the teachings of Suzuki and Warsing because both inventions teach waste processing/recycling and the idea of reading information from the product by using a scanner. Warsing teaches in col. 4, lines 18-28 that there are various codes marked inside the recycling design triangle. These codes are able to be scanned. Suzuki teaches that prior to recycling a product the information on the product can be acquired and used to determine the disposal method for and content of the product. There is also information on the product stored in a database within the system.

45. **With respect to claim 45:** Suzuki teaches the limitations in the rejections cited above. Suzuki does not teach, however Warsing teaches the server includes a receiver receiving the guarantee code. (col. 5, lines 20-48; col. 6, lines 10-25 – scanner/reader used to enter information regarding type of material code into computer)

It would have been obvious to one ordinary skill in the art at the time of the invention to combine the teachings of Suzuki and Warsing because both inventions teach waste processing/recycling and the idea of reading information from the product by using a scanner. Warsing teaches in col. 4, lines 18-28 that there are various codes marked inside the recycling design triangle. These codes are able to be scanned. Suzuki teaches that prior to recycling a product the information on the product can be

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acquired and used to determine the disposal method for and content of the product.

There is also information on the product stored in a database within the system.

46. **With respect to claim 47:** Suzuki teaches a recycle guarantee program enabling a computer to function as the server of any one of claims 43 to 46. (fig. 2-6; col. 7, 40-67; col. 9, lines 1-55; col. 10, lines 1-34 - product acquisition data obtained from product from database based on scanned information; information on recycling the product determined from factory capability; product acquisition data obtained from product; product separation information stored in system; product information stored in database)

47. **With respect to claim 48:** Suzuki teaches a recycle-guaranteed product whose recycling is guaranteed, and which has information for identifying recycle guarantee conditions. (fig. 2-6; col. 7, 40-67; col. 9, lines 1-55 - product acquisition data obtained from product; information on recycling the product determined from factory capability; product acquisition data obtained from product; product separation information stored in system)

48. **With respect to claim 49:** Suzuki teaches a recycle-guaranteed product whose recycling is guaranteed, and which has data for identifying recycle guarantee conditions stored in a data processing device and searched on the basis of the data. (fig. 2-6; col. 7, 40-67; col. 9, lines 1-55 - product acquisition data obtained from product; information on recycling the product determined from factory capability; product acquisition data obtained from product; product separation information stored in system)

49. **With respect to claim 50:** Suzuki teaches the recycle guarantee conditions include material processing conditions and service conditions of the produce made of the material. (fig. 2-6; col. 7, 40-67; col. 9, lines 1-55 - product acquisition data obtained from product; information on recycling the product determined from factory capability; product acquisition data obtained from product; product separation information stored in system)

50. **With respect to claim 51:** Suzuki teaches the information indicated on the product is for identifying the recycle guarantee conditions and a collecting condition depending upon a satisfaction level of the product with respect to the recycle guarantee conditions. (fig. 2-6; col. 7, 40-67; col. 9, lines 1-55 - product acquisition data obtained from product; information on recycling the product determined from factory capability; product acquisition data obtained from product; product separation information stored in system)

51. **With respect to claim 52:** Suzuki/Warsing teach the limitations cited in the rejections above. Suzuki/Warsing do not teach the following limitation however, Wagner teaches the waste collecting condition depends upon the satisfaction level of the product. (col. 30, line 56- col. 31, line 7 – rating system for client to rate product)

It would have been obvious to one ordinary skill in the art at the time of the invention to combine the teachings of Suzuki/Warsing and Wagner because both inventions teach waste processing/recycling and the idea of reading information from the product by using a scanner. The Suzuki/Warsing codes are able to be scanned. Suzuki teaches that prior to recycling a product the information on the product can be

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acquired and used to determine the disposal method for and content of the product. Wagner teaches that prior to disposal or reorder information regarding customer's opinion of product can be determined via a questionnaire.

52. **With respect to claim 53:** Suzuki/Warsing teach the limitations cited in the rejections above. Suzuki/Warsing do not teach the following limitation however, Wagner teaches the waste collecting condition denotes a collection fee. (col. 25, lines 45-64 – cost of disposing non-recyclables and bidding system for recyclables disposal)

It would have been obvious to one ordinary skill in the art at the time of the invention to combine the teachings of Suzuki/Warsing and Wagner because both inventions teach waste processing/recycling and the idea of reading information from the product by using a scanner. The Suzuki/Warsing codes are able to be scanned. Suzuki teaches that prior to recycling a product the information on the product can be acquired and used to determine the disposal method for and content of the product. Wagner teaches that prior to disposal or reorder information regarding customer's opinion of product can be determined via a questionnaire.

53. **With respect to claim 54:** Suzuki teaches the limitations in the rejections cited above. Suzuki does not teach, however Warsing teaches the product of any one of claims 48 to 53 is made of a plurality of materials. (col. 5, lines 20-48; col. 6, lines 10-25 – scanner/reader used to enter information regarding type of material code into computer)

54. **Claims 12-23 and 40-41** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Suzuki** in view of **Wagner**.

55. **With respect to claim 12:** Suzuki teaches a collecting condition of the material is applied in place of the collecting condition for the product. (fig. 2, item 100; col. 7, 40-67 - product acquisition data obtained from product)

56. **With respect to claim 13:** Suzuki/Wagner teaches the limitations in the rejections above. Suzuki/Wagner does not teach, however Warsing teaches the collecting condition for the product includes information concerning a waste collecting fee. (col. 3 - "this invention addresses this issue of collectors and governments charging fees as recyclable waste is picked up with identification of each recycler or household such as with bar codes on the bulk container and with bar codes, microchips, implant codes to credit or charge for the individual recyclable materials")

It would have been obvious to one ordinary skill in the art at the time of the invention to combine the teachings of Suzuki/Wagner and Warsing because both inventions teach waste processing/recycling and the idea of reading information from the product by using a scanner. Suzuki teaches that prior to recycling a product the information on the product can be acquired and used to determine the disposal method for and content of the product. Wagner teaches that prior to disposal there should be a bidding process to chose a waste disposal company. Warsing teaches that the disposal company will eventually charge the customer a fee for their service.

57. **With respect to claim 14:** Suzuki teaches the limitations in the rejections above. Suzuki does not teach, however Wagner teaches the collecting condition for the product

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includes information concerning a collector. (col. 11, "Waste Pickup Provider Preference" section in the chart discusses provider identifier and provider who won the bid)

It would have been obvious to one ordinary skill in the art at the time of the invention to combine the teachings of Suzuki and Wagner because both inventions teach waste processing/recycling and the idea of reading information from the product by using a scanner. Suzuki teaches that prior to recycling a product the information on the product can be acquired and used to determine the disposal method for and content of the product. Wagner teaches that prior to disposal there should be a bidding process to chose a waste disposal company. This process includes obtaining information about the companies participating.

58. **With respect to claim 15:** Suzuki teaches the limitations in the rejections above. Suzuki does not teach, however Wagner teaches the server receives information concerning the satisfaction level of the product from a product maker's terminal and a consumer's terminal. (col. 30, line 56- col. 31, line 7; col. 33, lines 1-19 – rating system for client to rate product; system can be instructed to provide confirmatory communications via email or a website page etc.)

It would have been obvious to one ordinary skill in the art at the time of the invention to combine the teachings of Suzuki and Wagner because both inventions teach waste processing/recycling and the idea of reading information from the product by using a scanner. Suzuki teaches that prior to recycling a product the information on the product can be acquired and used to determine the disposal method for and content

of the product. Wagner teaches that prior to disposal or reorder information regarding customer's opinion of product can be determined via a questionnaire.

59. **With respect to claim 16:** Suzuki teaches the limitations in the rejections above. Suzuki does not teach, however Wagner teaches the satisfaction level determining information relates to a collection fee depending upon a state of the product discarded as a waste. (col. 25, lines 45-64 – cost of disposing non-recyclables and bidding system for recyclables disposal)

It would have been obvious to one ordinary skill in the art at the time of the invention to combine the teachings of Suzuki and Wagner because both inventions teach waste processing/recycling and the idea of reading information from the product by using a scanner. Suzuki teaches that prior to recycling a product the information on the product can be acquired and used to determine the disposal method for and content of the product. Wagner teaches that prior to disposal or reorder information regarding customer's opinion of product can be determined via a questionnaire.

60. **With respect to claim 17:** Suzuki teaches the recycle guarantee conditions for the material are inputted in the server prior to the material making. (figs. 2-4; col. 7, 40-67 - product acquisition data obtained from product; product separation information stored in system)

61. **With respect to claim 18:** Suzuki teaches the recycle guarantee conditions for the material are inputted in the server after the material making. (fig. 2-6; col. 9, lines 1-55 - product acquisition data obtained from product; information on recycling the product determined from factory capability)

62. **With respect to claim 19:** Suzuki teaches the recycle guarantee conditions for the material are established at respective stages in the life cycle of the product. (fig. 2-6; col. 7, 40-67; col. 9, lines 1-55 - product acquisition data obtained from product; information on recycling the product determined from factory capability; product acquisition data obtained from product; product separation information stored in system)

63. **With respect to claims 20 and 40:** Suzuki teaches the recycle guarantee conditions for the material include material processing conditions and service conditions of the product made of the material. (figs. 2-4; col. 7, 40-67 - product acquisition data obtained from product; product separation information stored in system)

64. **With respect to claim 21:** Suzuki teaches the material recycling conditions include conditions for processing the material and for breaking down the product waste. (figs. 2-4; col. 7, 40-67 - product acquisition data obtained from product; product separation information stored in system)

65. **With respect to claims 22 and 41:** Suzuki/Wagner teaches the limitations in the rejections above. Suzuki/Wagner does not teach, however Warsing teaches the product is furniture made of a wooden material. (col. 5, lines 40-41 – yard waste and brush recycled as wood chips)

It would have been obvious to one ordinary skill in the art at the time of the invention to combine the teachings of Suzuki/Wagner and Warsing because both inventions teach waste processing/recycling and the idea of reading information from the product by using a scanner. Suzuki teaches that prior to recycling a product the information on the product can be acquired and used to determine the disposal method

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for and content of the product. Product can be any trash content. Wagner teaches that prior to disposal there should be a bidding process to chose a waste disposal company. Warsing teaches that the wooden material can be recycled.

Furthermore, the data identifying "type of product" is non-functional descriptive data.

When presented with a claim comprising descriptive material, an Examiner must determine whether the claimed nonfunctional descriptive material should be given patentable weight. The Patent and Trademark Office (PTO) must consider all claim limitations when determining patentability of an invention over the prior art. *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401,404 (Fed. Cir. 1983). The PTO may not disregard claim limitations comprised of printed matter. *See Gulack*, 703 F.2d at 1384-85, 217 USPQ at 403; *see also Diamond v. Diehr*, 450 U.S. 175, 191, 209 USPQ 1, 10 (1981). However, the examiner need not give patentable weight to descriptive material absent a new and unobvious functional relationship between the descriptive material and the subset. *See In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994); *In re Ngai*, 367 F.3d 1336, 1338, 70 USPQ2d 1862, 1863-64 (Fed. Cir. 2004). Thus, when the prior art describes all the claimed structural and functional relationships between the descriptive material and the subset, but the prior art describes a different descriptive material than the claim, then the descriptive material is nonfunctional and will not be given any patentable weight. That is, such a scenario presents no new and unobvious functional relationship between the descriptive material and the subset.

The Examiner asserts that the data identifying "type of product" adds little, if anything, to the claimed acts or steps and thus do not serve as limitations on the claims to distinguish over the prior art. MPEP 2106IV b 1(b) indicates that "nonfunctional descriptive material" is material "that cannot exhibit any functional interrelationship with the way the steps are performed". Any differences related merely to the meaning and information conveyed through data, which does not explicitly alter or impact the steps is non-functional descriptive data. The subjective interpretation of the data does not patentably distinguish the claimed invention.

66. **With respect to claims 23 and 42:** Suzuki/Wagner teaches the limitations in the rejections above. Suzuki/Wagner does not teach, however Warsing teaches the product is a bottle made of polyethylene terephthalate. (col. 4, lines 18-28 – code 1=PET represents of polyethylene terephthalate)

Furthermore, the data identifying "type of bottle" is non-functional descriptive data.

When presented with a claim comprising descriptive material, an Examiner must determine whether the claimed nonfunctional descriptive material should be given patentable weight. The Patent and Trademark Office (PTO) must consider all claim limitations when determining patentability of an invention over the prior art. *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401,404 (Fed. Cir. 1983). The PTO may not disregard claim limitations comprised of printed matter. *See Gulack*, 703 F.2d at 1384-85, 217 USPQ at 403; *see also Diamond v. Diehr*, 450 U.S. 175, 191, 209 USPQ 1, 10 (1981). However, the examiner need not give patentable weight to descriptive material absent a

new and unobvious functional relationship between the descriptive material and the subset. See *In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994); *In re Ngai*, 367 F.3d 1336, 1338, 70 USPQ2d 1862, 1863-64 (Fed. Cir. 2004). Thus, when the prior art describes all the claimed structural and functional relationships between the descriptive material and the subset, but the prior art describes a different descriptive material than the claim, then the descriptive material is nonfunctional and will not be given any patentable weight. That is, such a scenario presents no new and unobvious functional relationship between the descriptive material and the subset.

The Examiner asserts that the data identifying "type of bottle" adds little, if anything, to the claimed acts or steps and thus do no serve as limitations on the claims to distinguish over the prior art. MPEP 2106IV b 1(b) indicates that "nonfunctional descriptive material" is material "that cannot exhibit any functional interrelationship with the way the steps are performed". Any differences related merely to the meaning and information conveyed through data, which does not explicitly alter or impact the steps is non-functional descriptive data. The subjective interpretation of the data does not patentably distinguish the claimed invention.

67. **Claim 30** is rejected under 35 U.S.C. 103(a) as being unpatentable over **Warsing** in view of **Wagner**.

68. **With respect to claim 30:** Warsing teaches the limitation cited in the rejections above. Warsing does not teach, however Wagner teaches wherein one of the three

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conditions of the recycle guarantee information is recorded. (col. 5, lines 35-51 – scanner used to scan item packaging)

It would have been obvious to one ordinary skill in the art at the time of the invention to combine the teachings of Warsing and Wagner because both inventions teach waste processing/recycling and the idea of reading information from the product by using a scanner. The Warsing codes are able to be scanned. Wagner teaches that prior to disposal or reorder information regarding customer's opinion of product can be determined via a questionnaire.

CONCLUSION

69. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Heidi Riviere whose telephone number is 571-270-1831. The examiner can normally be reached on Monday-Friday 9:00am-5:00pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janice Mooneyham can be reached on 571-272-6805. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/H. R./
Examiner, Art Unit 3689

/Dennis Ruhl/
Primary Examiner, Art Unit 3689